

### **REMARKS**

Claims 1-5, 7-15 and 17-20 were pending in the application. Claim 1 is an independent claim, and claims 2-5 and 7-10 depend there from. Claim 11 is an independent claim, and claims 12-15 and 17-19 depend there from. Claim 20 is an independent claim. Claims 1, 7, 11, 17 and 20 are currently amended. Applicants respectfully request that the application be reconsidered in view of the amendments set forth above and the following remarks.

### **Rejections Under 35 U.S.C. §103(a) – Gatts and Cohen**

In point 3 on page 2 of the non-final Office Action, independent claims 1 and 11, and dependent claims 2-5, 7-8, 12-15 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatts et al., U.S. Patent 6,004,259 (hereinafter “Gatts”) in view of Cohen, U.S. Patent No. 4,969,867. The Applicants respectfully traverse the rejections for at least the reasons set forth below.

With regard to an obviousness rejection, MPEP 2142 states that in order for a prima facie case of obviousness to be established, three basic criteria must be met, one of which is that the reference or combination of references must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination”, and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so’” (citing *In re Mills*, 916 F. 2d 680, 16 USPQ 2d 1430 (Fed Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F. 3d 1308, 50 USPQ 2d. 1161 (Fed Cir. 1999).

The proposed combination of Gatts and Cohen are different from Applicant's amended independent claim 1 since they do not teach or suggest by themselves or in combination, *inter alia*, the claimed method steps of "receiving at least one triggering event by an audio enabled toy comprising a stuffed animal," and "determining from within said audio enabled toy, a playback operating mode from a plurality of playback operating modes based on said received triggering event, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode."

Rather, Gatts discloses a system including "a sound transducer 2 disposed in the cradle 1 beneath the level of the infant positioned therein on mattress 33." (Gatts, Column 3, Lines 52-54 (emphasis added)). Further, Gatts discloses "automatically var[ying] the environmental stimuli of the cradle in a day-night cycle to simulate the mother's activities while awake or sleeping.... The solar sensor 4 detects reduced ambient light and switches to the "nighttime" program of motion and sound. Of course, such day or night operating programs may also be implemented under control of a timer or manual switch." (Gatts, Column 7, Lines 3-13 (emphasis added)). Additionally, "the simulated heart beat rate is about 80 beats per minute for daytime operation and about 62 beats per minute for nighttime operation to simulate typical active and at-rest heart rates." (Gatts, Column 11, Lines 5-9 (emphasis added)).

Cohen discloses an "[a]pparatus for promoting sleep in an individual, comprises a blanket, mattress, pillow or similar article adapted to be placed against and or around the individual; a plurality of compressional-wave transducers incorporated in the article at a plurality of locations for producing compressional waves; and an electrical circuit for generating electrical signals energizing the transducers to produce sleep-promoting compressional waves at the plurality of different locations." (Cohen, Column 3, Lines 8-9 (emphasis added)). Cohen further clarifies the apparatus by stating "the blanke[t] (or mattress, or pillow, or combination of them) containing the transducers...." (Cohen, Column 3, Lines 8-9 (emphasis added)).

The proposed combination of Gatts and Cohen at least fail to disclose, for example, "determining from within said audio enabled toy, a playback operating mode from a plurality of

playback operating modes based on said received triggering event, **wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode,**” as set forth in Applicant’s amended claim 1. Cohen is silent regarding a plurality of playback operating modes and fails to disclose an increasing heartbeat mode and a decreasing heartbeat mode. Gatts discloses a daytime playback operating mode and a nighttime playback operating mode. However, the daytime playback operating mode and nighttime playback operating mode disclosed in Gatts teaches constant heartbeat rates (i.e., 80 beats per minute for daytime operation and about 62 beats per minute for nighttime operation). The non-final Office Action states that “[h]eartbeat sounds (or other sounds indicative of a uterine sound) may also be manipulated (increased) and generated by the cradle (col. 9, lines 56-64). . . .” (Office Action, Page 3, Lines 2-4). The cited section of Gatts states the following:

State DAYS-OFF is equivalent to nighttime. Once the day count reaches 5,000, which means light is detected much more frequently than no light, the system increments the motor dwell to the day dwell value. It also changes the state to DAYS-TON (days turn on), which increments the volume of the sound which includes heart sounds (the beat rate of which is also increased), and increments motor speeds every minute until they reach the preset daytime values.

(Gatts, Column 9, Lines 56-64). As demonstrated by the cited section of Gatts, Gatts does not teach an increasing heartbeat playback operating mode. Rather, Gatts discloses a nighttime playback operating mode and a daytime operating mode, wherein the motor speed, volume and heart sound rate can transition from the nighttime playback operating mode to the daytime playback operating mode. Therefore, Gatts fails to disclose “determining from within said audio enabled toy, a playback operating mode from a plurality of playback operating modes based on said received triggering event, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode,” as set forth in Applicant’s amended claim 1. Because Gatts alone, Cohen alone and the combination of Gatts and Cohen fails to teach or suggest all the claim limitations as required by MPEP 2142, a rejection under 35 U.S.C. §103(a) cannot be maintained.

Additionally, the proposed combination of Gatts and Cohen at least fail to disclose, for example, “receiving at least one triggering event by an audio enabled toy comprising a stuffed animal,” as set forth in Applicant’s amended claim 1. The Applicant appreciates the Examiner’s recognition in the non-final Office Action that “Gatts fails to teach such a method carried out by an audio enabled toy.” (Office Action, Page 3, Line 8). Cohen fails to remedy the deficiencies of Gatts. The non-final Office Action states that “Cohen teaches a blanket, mattress, pillow or similar article to be placed against an infant for promoting sleep. Regarding the ‘audio enabled toy’ of claim 1, Cohen teaches a blanket, pillow or other item of similar dimensions that is small and would pacify an infant (col. 1, lines 6-9), thus constituting a ‘toy.’” (Office Action, Page 3, Lines 8-12). However, the cited section of Cohen states that “[t]he present invention relates to sleep-promoting and/or pacification apparatus, and particularly to apparatus useful for promotion [sic] sleep and/or pacifying adults or infants.” (Cohen, Column 1, Lines 6-9). Nowhere in the cited section of Cohen is there any mention of a toy. Cohen does disclose a “blanke[t] (or mattress, or pillow, or combination of them).” (Cohen, Column 3, Lines 8-9). A toy is different than a blanket, a mattress, a pillow and/or any combination of a blanket, mattress and/or pillow. Further, the Applicant has amended claim 1 to recite “receiving at least one triggering event by an audio enabled toy comprising a stuffed animal.” Clearly, neither Gatts nor Cohen, alone or in any combination, discloses an audio enabled toy comprising a stuffed animal. Because Gatts alone, Cohen alone and the combination of Gatts and Cohen fails to teach or suggest all the claim limitations as required by MPEP 2142, a rejection under 35 U.S.C. §103(a) cannot be maintained.

With regard to Applicant’s independent, amended claim 11, the proposed combination of Gatts and Cohen are different from Applicant’s amended independent claim 11 since they do not teach or suggest by themselves or in combination, *inter alia*, “a processing circuit that receives at least one triggering event by an audio enabled toy comprising a stuffed animal” and “said processing circuit determines a playback operating mode from a plurality of playback operating modes based on said received triggering event and selects from within said audio enabled toy, at least one sound that mimics a mother’s sound from a plurality of mother’s sounds based on said

determined playback operating mode, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode.

Rather, Gatts discloses a system including “a sound transducer 2 disposed in the cradle 1 beneath the level of the infant positioned therein on mattress 33.” (Gatts, Column 3, Lines 52-54 (emphasis added)). Further, Gatts discloses “automatically var[ying] the environmental stimuli of the cradle in a day-night cycle to simulate the mother’s activities while awake or sleeping.... The solar sensor 4 detects reduced ambient light and switches to the “nighttime” program of motion and sound. Of course, such day or night operating programs may also be implemented under control of a timer or manual switch.” (Gatts, Column 7, Lines 3-13 (emphasis added)). Additionally, “the simulated heart beat rate is about 80 beats per minute for daytime operation and about 62 beats per minute for nighttime operation to simulate typical active and at-rest heart rates.” (Gatts, Column 11, Lines 5-9 (emphasis added)).

Cohen discloses an “[a]pparatus for promoting sleep in an individual, comprises a blanket, mattress, pillow or similar article adapted to be placed against and or around the individual; a plurality of compressional-wave transducers incorporated in the article at a plurality of locations for producing compressional waves; and an electrical circuit for generating electrical signals energizing the transducers to produce sleep-promoting compressional waves at the plurality of different locations.” (Cohen, Column 3, Lines 8-9 (emphasis added)). Cohen further clarifies the apparatus by stating “the blanke[t] (or mattress, or pillow, or combination of them) containing the transducers....” (Cohen, Column 3, Lines 8-9 (emphasis added)).

The proposed combination of Gatts and Cohen at least fail to disclose, for example, “said processing circuit determines a playback operating mode from a plurality of playback operating modes based on said received triggering event and selects from within said audio enabled toy, at least one sound that mimics a mother’s sound from a plurality of mother’s sounds based on said determined playback operating mode, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing

**heartbeat mode**,” as set forth in Applicant’s amended claim 11. Cohen is silent regarding a plurality of playback operating modes and fails to disclose an increasing heartbeat mode and a decreasing heartbeat mode. Gatts discloses a daytime playback operating mode and a nighttime playback operating mode. However, the daytime playback operating mode and nighttime playback operating mode disclosed in Gatts teaches constant heartbeat rates (i.e., 80 beats per minute for daytime operation and about 62 beats per minute for nighttime operation). The non-final Office Action states that “[h]eartbeat sounds (or other sounds indicative of a uterine sound) may also be manipulated (increased) and generated by the cradle (col. 9, lines 56-64). . . .” (Office Action, Page 3, Lines 2-4). The cited section of Gatts states the following:

State DAYS-OFF is equivalent to nighttime. Once the day count reaches 5,000, which means light is detected much more frequently than no light, the system increments the motor dwell to the day dwell value. It also changes the state to DAYS-TON (days turn on), which increments the volume of the sound which includes heart sounds (the beat rate of which is also increased), and increments motor speeds every minute until they reach the preset daytime values.

(Gatts, Column 9, Lines 56-64). As demonstrated by the cited section of Gatts, Gatts does not teach an increasing heartbeat playback operating mode. Rather, Gatts discloses a nighttime playback operating mode and a daytime operating mode, wherein the motor speed, volume and heart sound rate can transition from the nighttime playback operating mode to the daytime playback operating mode. Therefore, Gatts fails to disclose “said processing circuit determines a playback operating mode from a plurality of playback operating modes based on said received triggering event and selects from within said audio enabled toy, at least one sound that mimics a mother’s sound from a plurality of mother’s sounds based on said determined playback operating mode, wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode,” as set forth in Applicant’s amended claim 11. Because Gatts alone, Cohen alone and the combination of Gatts and Cohen fails to teach or suggest all the claim limitations as required by MPEP 2142, a rejection under 35 U.S.C. §103(a) cannot be maintained.

Additionally, the proposed combination of Gatts and Cohen at least fail to disclose, for example, “a processing circuit that receives at least one triggering event by **an audio enabled toy comprising a stuffed animal**,” as set forth in Applicant’s amended claim 11. The Applicant appreciates the Examiner’s recognition in the non-final Office Action that “Gatts fails to teach such a method carried out by an audio enabled toy.” (Office Action, Page 4, Line 9-10). Cohen fails to remedy the deficiencies of Gatts. The non-final Office Action states that “[r]egarding the ‘audio enabled toy’ of claim 11, Cohen teaches a blanket, pillow or other item of similar dimensions that is small and would pacify an infant (col. 1, lines 6-9), thus constituting a ‘toy.’” (Office Action, Page 4, Lines 10-12). However, the cited section of Cohen states that “[t]he present invention relates to sleep-promoting and/or pacification apparatus, and particularly to apparatus useful for promotion [sic] sleep and/or pacifying adults or infants.” (Cohen, Column 1, Lines 6-9). Nowhere in the cited section of Cohen is there any mention of a toy. Cohen does disclose a “blanke[t] (or mattress, or pillow, or combination of them).” (Cohen, Column 3, Lines 8-9). A toy is different than a blanket, a mattress, a pillow and/or any combination of a blanket, mattress and/or pillow. Further, the Applicant has amended claim 11 to recite “a processing circuit that receives at least one triggering event by an audio enabled toy comprising a stuffed animal.” Clearly, neither Gatts nor Cohen, alone or in any combination, discloses an audio enabled toy comprising a stuffed animal. Because Gatts alone, Cohen alone and the combination of Gatts and Cohen fails to teach or suggest all the claim limitations as required by MPEP 2142, a rejection under 35 U.S.C. §103(a) cannot be maintained.

The Applicant respectfully submits that, based upon the above, the proposed combination of Gatts and Cohen fails to teach or suggest by themselves or in combination all of the limitations of Applicant’s independent claims 1 and 11, and that rejections of claim 1 and 11 under 35 U.S.C. §103(a) cannot be maintained. Therefore, Applicant respectfully requests that the rejections of claim 1 and 11 under 35 U.S.C. §103(a), be withdrawn.

Because dependent claims 2-5, 7-8, 12-15 and 17-18 depend, directly or indirectly, from independent claim 1 or 11, and because claims 1 and 11 are allowable over the proposed combination of references, the Applicant asserts that rejections of dependent claims 2-5, 7-8, 12-15 and 17-18 are now moot. The Applicant asserts that claims 2-5, 7-8, 12-15 and 17-18 are also allowable over the proposed combination of references and requests that the rejections of claims 2-5, 7-8, 12-15 and 17-18 be withdrawn.

**Rejections Under 35 U.S.C. §103(a) – Gatts, Cohen and Kulick**

In point 4 on page 4 of the non-final Office Action, independent claim 20, and dependent claims 9, 10 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatts in view of Cohen and further in view of Kulick, U.S. Patent No. 6,692,330. The Applicants respectfully traverse the rejections for at least the reasons set forth below.

With regard to an obviousness rejection, MPEP 2142 states that in order for a prima facie case of obviousness to be established, three basic criteria must be met, one of which is that the reference or combination of references must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination”, and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so’” (citing *In re Mills*, 916 F. 2d 680, 16 USPQ 2d 1430 (Fed Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F. 3d 1308, 50 USPQ 2d. 1161 (Fed Cir. 1999).

The proposed combination of Gatts, Cohen and Kulick are different from Applicant’s amended independent claim 20 since they do not teach or suggest by themselves or in



combination, *inter alia*, “a mode control unit coupled to said processing circuit for determining a playback operating mode from a plurality of playback operating modes, **wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode.**”

As demonstrated above, neither Gatts nor Cohen, alone or in any combination, discloses “a mode control unit coupled to said processing circuit for determining a playback operating mode from a plurality of playback operating modes, **wherein said plurality of playback operating modes comprises a constant heartbeat mode, an increasing heartbeat mode and a decreasing heartbeat mode,**” as set forth in Applicant’s amended claim 20. Kulick fails to remedy the deficiencies of Gatts and Cohen. Kulick discloses “[a]n infant toy includes a body portion having an interior cavity within which an audio device is disposed. The body portion has a soft exterior surface. The audio device has ‘play’ and ‘record’ functions, both of which may be activated manually or by voice. The audio device has the capability of playing pre-recorded sounds such as soothing music, user-recorded sounds such as the parent’ voices, or a combination of pre-recorded sounds and user-recorded sounds. The toy can cease operation after a predetermined period of time. By setting the toy in the voice-activated mode, the toy can comfort an infant when necessary and turn itself off after the infant has fallen asleep.” (Kulick, Abstract). Nowhere in Kulick is there any mention of a plurality of playback operating modes, a constant heartbeat mode, an increasing heartbeat mode and/or a decreasing heartbeat mode. Because Gatts alone, Cohen alone, Kulick alone and any combination of Gatts, Cohen and Kulick fails to teach or suggest all the claim limitations as required by MPEP 2142, a rejection under 35 U.S.C. §103(a) cannot be maintained.

The Applicant respectfully submits that, based upon the above, the proposed combination of Gatts, Cohen and Kulick fails to teach or suggest by themselves or in combination all of the limitations of Applicant’s independent claim 20, and that rejection of claim 20 under 35 U.S.C. §103(a) cannot be maintained. Therefore, Applicant respectfully requests that the rejection of claim 20 under 35 U.S.C. §103(a), be withdrawn.

As discussed previously with regard to at least independent claims 1 and 11, Gatts, Cohen and the combination of Gatts and Cohen does not teach all of the claim limitations. Accordingly, Gatts, Cohen and the combination of Gatts and Cohen does not teach all of the limitations of any of the associated dependent claims, including claims 9, 10 and 19. Additionally, Kulick fails to make up for the aforementioned deficiencies of Gatts, Cohen and the combination of Gatts and Cohen.

Accordingly, based at least on the foregoing, including arguments presented previously with regard to independent claims 1 and 11, the Applicant respectfully submits that dependent claims 9, 10 and 19 are allowable over Gatts, Cohen, Kulick and any combination of Gatts, Cohen and Kulick. Therefore, the Applicant respectfully requests that the rejections of claims 9, 10 and 19 be withdrawn.

Applicants reserve the right to argue additional reasons supporting the allowability of claims 1-5, 7-15 and 17-20 should the need arise in the future.

**CONCLUSION**

Applicant respectfully submits that claims 1-5, 7-15 and 17-20 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: November 13, 2007

Respectfully submitted,

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